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OCT 07 2009

OFFICE OF PETITIONS

In re Application of :
Jones et al. :
Application No. 08/833095 : ON PETITION
Filing or 371(c) Date: 04/04/1997 :
Patent Number: 5,966,456 :
Issue Date: 10/12/1999 :
Attorney Docket Number: CUMM:183 :

This is a decision on the "Petition for Correction of Inventorship Under 37 C.F.R. 1.324," and "Submission of the Rules Under §1.183 for Statements of Deceased and Unavailable Inventors Under §1.324(B)(1)," filed September 22, 2003, and on the Supplemental Petition for Correction of Inventorship Under 37 C.F.R. 1.324," filed October 31, 2003.

The petition is **DISMISSED as moot.**

The application as-filed listed two inventors: William J. Jones and Douglas U. Mennie. Petitioner files the present petition and supplement requesting correction of inventorship to add as inventors Donald E. Raterman, Bradford T. Graves, Lars R. Stromme and Aaron M. Bauch.

Petitioner files statements from Evelyn Raterman (widow of the late Donald E. Raterman), Bradford T. Graves, Lars R. Stromme (on behalf of unavailable inventor, Lars R. Stromme), and Aaron M. Bauch, along with a statement from current named inventors William J. Jones and Douglas U. Mennie.

Petitioner provides that a statement from Donald E. Raterman cannot be obtained because he is deceased, and that a statement from Lars R. Stromme cannot be obtained because he is unavailable.

Applicable Law, Rules and MPEP in effect in September and October, 2003

35 U.S.C. § 256. Correction of named inventor, stated:

Whenever through error a person is named in an issued patent as the inventor, or through error an inventor is not named in an issued patent and such error arose without any deceptive intention on his part, the Director may, on application of all the parties and assignees, with proof of the facts and such other requirements as may be imposed, issue a certificate correcting such error. The error of omitting inventors or naming persons who are not inventors shall not invalidate the patent in which such error occurred if it can be corrected as provided in this section. The court before which such matter is called in question may order correction of the patent on notice and hearing of all parties concerned and the Director shall issue a certificate accordingly. In requesting the Office to effectuate a court order correcting inventorship in a patent pursuant to 35 U.S.C. 256, a copy of the court order and a Certificate of Correction under 37 CFR 1.323 should be submitted to the Certificates of Corrections Branch. (Emphasis supplied).

37 CFR § 1.324. Correction of inventorship in patent, pursuant to 35 U.S.C. 256, stated:

(a) Whenever through error a person is named in an issued patent as the inventor, or through error an inventor is not named in an issued patent and such error arose without any deceptive intention on his or her part, the Commissioner may, on petition, or on order of a court before which such matter is called in question, issue a certificate naming only the actual inventor or inventors. A petition to correct inventorship of a patent involved in an interference must comply with the requirements of this section and must be accompanied by a motion under § 1.634.

(b) Any petition pursuant to paragraph (a) of this section must be accompanied by:

(1) Where one or more persons are being added, a statement from each person who is being added as an inventor that the inventorship error occurred without any deceptive intention on his or her part;

(2) A statement from the current named inventors who have not submitted a statement under paragraph (b)(1) of this section either agreeing to the change of inventorship or stating that they have no disagreement in regard to the requested change;

(3) A statement from all assignees of the parties submitting a statement under paragraphs (b)(1) and (b)(2) of this section agreeing to the change of inventorship in the patent, which statement must comply with the requirements of § 3.73(b) of this chapter; and

(4) The fee set forth in § 1.20(b).

37 CFR § 1.183, Suspension of rules, stated

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, sua sponte, or on petition of the interested party, subject to such other requirements as may be imposed.

The MPEP 1481 provided:

the statutory basis for corrections of inventorship in applications under 37 CFR 1.48. 35 U.S.C. 256 requires "on application of all the parties and assignees," while 35 U.S.C. 116 does not have the same requirement. Under 35 U.S.C. 116 and 37 CFR 1.48, waiver requests under 37 CFR 1.183 may be submitted (see, e.g., MPEP § 201.03, under the heading "Statement of Lack of Deceptive Intention"). This is not possible under 35 U.S.C. 256 and 37 CFR 1.324. In correction of inventorship in a nonprovisional application under 37 CFR 1.48(a), the requirement for a statement by each originally named inventor may be waived pursuant to 37 CFR 1.183; however, correction of inventorship in a patent under 37 CFR 1.324 requires petition of all the parties, i.e., originally named inventors and assignees, in accordance with statute (35 U.S.C. 256) and thus the requirement cannot be waived.

Analysis/conclusion

Suspension of the rules under 37 CFR 1.183 may be granted for any requirement of the regulations which is not a requirement of the statutes. In this instance, 35 U.S.C. 256 requires that the application be made by all of the parties and assignees. Petitioner provides that a statement from Donald E. Raterman cannot be obtained because he is deceased, and that a statement from Lars R. Stromme cannot be obtained because he is unavailable. Accordingly, the petition under 37 CFR 1.183 is dismissed as moot.

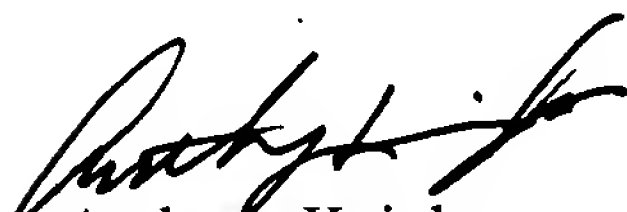
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